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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,757	12/30/2003	Nikolai G. Nikolov	6570P037	9105
45962	7590	09/17/2009		
SAP/BSTZ BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER KISS, ERIC B	
			ART UNIT 2192	PAPER NUMBER
			MAIL DATE 09/17/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,757

Applicant(s)

NIKOLOV, NIKOLAI G.

Examiner

ERIC B. KISS

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 20090714, 20090716
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 14, 2009, has been entered. Claims 40-54 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 40-54 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 41, 46, and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 41, 46, and 51 contain the trademark/trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product.

A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a particular software architecture and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 40-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,662,359 (Berry et al.) in view of U.S. Patent No. 6,560,618 (Ims).

Regarding claim 40, *Berry et al.* discloses a method comprising reading program code from memory and processing said program code with one or more processors to perform the following:

providing a user with options for modifying an application's bytecode, said application composed of class files, said class files having respective methods, said options including one or more of the following:

- i) modifying bytecode of classfiles within only one [application] file;
- ii) modifying bytecode of only one classfile;

iii) modifying bytecode of only one method within any one of the [application's] respective classfiles (*see, e.g., Berry et al.* at col. 5, line 59, through col. 6, lines 45; col. 7, lines 5-11 (selective instrumentation of some or all methods));

modifying bytecode of said application in accordance with said user's selection of one of said options (*see, e.g., Berry et al.* at col. 5, line 59, through col. 6, lines 45; col. 6, line 51, through col. 7, line 17);

executing said application in an object oriented runtime frame work, said executing including processing a portion of said application's bytecode that was modified in accordance with said user's selection of one or more of said options (*see, e.g., Berry et al.* at col. 7, lines 44-45); and,

presenting to said user an output generated from execution of said portion of said application's bytecode that was modified (*see, e.g., Berry et al.* at col. 6, lines 55-65).

Berry et al. fails to expressly disclose said application composed of a plurality of archive files, said archive files having respective class files. However, *Im*s teaches that it has been known for JAVA applications (like those modified by *Berry*) to be arranged into archive files to ensure that all required files and classes are available (*see, e.g., Im*s at col. 2, lines 1-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize archive files as a known means of organizing JAVA applications.

Regarding claim 41, *Berry et al.* further discloses said object oriented runtime framework being a JAVA object oriented runtime framework (*see, e.g., Berry et al.* at col. 4, lines 22-29).

Regarding claim 42, *Berry et al.* further discloses said application's bytecode that was modified including a method entry or method exit (*see, e.g., Berry et al.* at col. 6, line 51, through col. 7, line 17).

Regarding claim 43, *Berry et al.* further discloses said output being provided by a plug-in that a bytecode instruction inserted at said method entry or method exit is dispatched to (*see, e.g., Berry et al.* at col. 6, line 51, through col. 7, line 17).

Regarding claim 44, *Berry et al.* further discloses said output including one of: a time at which said method entry or method exit was entered; and, a parameter that is passed at said method entry or method exit (*see, e.g., Berry et al.* at col. 6, lines 1-16; col. 6, line 51, through col. 7, line 17).

Regarding claims 45-49, these are machine-readable storage medium versions of the claimed methods discussed above (claims 40-44). *Berry et al.* further discloses the use of such media to implement the prescribed methods (*see, e.g., Berry et al.* at col. 14, lines 30-44), and all other limitations have been addressed as set forth above.

Regarding claims 50-54, these are computer system versions of the claimed methods discussed above (claims 40-44). *Berry et al.* further discloses the use of such systems/software to implement the prescribed methods (*see, e.g., Berry et al.* at col. 14, lines 30-44), and all other limitations have been addressed as set forth above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The

examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric B. Kiss/
Eric B. Kiss
Primary Examiner, Art Unit 2192